

REMARKS

The Official Action mailed March 13, 2003 has been received and its contents carefully noted. Filed concurrently herewith is a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to July 13, 2003. Accordingly, Applicant respectfully submits that this response is being timely filed.

Applicant notes with appreciation the partial consideration of the Information Disclosure Statement filed on November 19, 2001. Applicant awaits consideration of the Information Disclosure Statements filed March 12, 2002; December 23, 2002; March 3, 2003; April 28, 2003; April 28, 2003, and May 29, 2003.

The Official Action states that the complaint/answer are not prior art and thus are not considered. It is noted that 37 CFR 1.56 imposes a duty to disclose all material information, and that such information may or may not qualify as prior art under 35 U.S.C. 102. Furthermore, MPEP 2001.06(c) specifically discusses information from related litigation and indicates that such information should be submitted. In view thereof, submission of these litigation related documents is believed to be proper and it is requested that the Examiner return an initialed Form 1449 or other indication that the submitted information has been fully considered and does not affect the patentability of the claims.

Claims 1-37 were pending in the present application. Claims 1-34 and 36-37 have been cancelled and new claims 38-60 have been added to recite additional protection to which Applicant is entitled. Claim 35 has been amended. Claims 35 and 38-60 are now pending in the present application, of which claims 35, 38-42 and 54-55 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance.

The Official Action apparently rejects claims 1-37 as obvious based on the combination of U.S. Patent 5,089,750 to Hatada and U.S. Patent 4,740,657 to Tsukagoshi. With respect to claims 9 and 16, the Official Action admits that the combination of Harada and Tsukagoshi fails to disclose the ratio of the hard particles lower than the resilient particles, but asserts that this is a matter of design choice.

As stated in MPEP § 2143-2143.01, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Claim 35 has been amended herewith to recite that "one of the first end and the second end of the first electrode is inside of an edge of the substrate" as shown in Figure 3 of the subject application, for example. This same limitation is included in the newly added independent claims. It is respectfully submitted that this feature is not disclosed or suggest by either of Hatada or Tsukagoshi. Since the prior art, whether taken alone or in combination fails to disclose or suggest each and every limitation recited in the claims, a *prima facie* case of obviousness cannot be maintained and favorable reconsideration is requested.

In addition, new claims 39, 40, 54 and 55 recite a further limitation that "the second electrode is coated with Ni and Au." This limitation is supported by at least page 5, lines 20-21 of the specification. It is respectfully submitted that this feature is not disclosed in Hatada or Tsukagoshi and thus these claims are further patentably distinguished over the prior art of record for this reason.

Also, new claims 41, 42, 54 and 55 recite another limitation that "a diameter of the conductive particle decreases at least 34% after applying a pressure." This limitation is supported by the disclosure on page 6, lines 8-10 and lines 17-19. The hard particles 5 μ m thick are included in order to prevent the conductive resilient particles

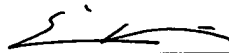
7.5 μ m thick from being destroyed under excess pressure. Therefore, a diameter of the conductive particles (the conductive resilient particles) is 5 μ m after applying a pressure and thus the diameter of the conductive particle decreases by 34% $\left(1 - \left(\frac{5\mu\text{m}}{7.5\mu\text{m}}\right) * 100\%\right)$. This feature is also not disclosed in Hatada or Tsukagoshi.

Finally, it is respectfully submitted that U.S. Patent 4,985,663 to Nakatani does not appear to disclose or suggest the above limitations.

For all of the above reasons, it is respectfully submitted that the pending claims of the subject application are in condition for allowance and favorable reconsideration is requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact Applicant's undersigned attorney at the telephone number listed below.

Respectfully submitted,



Eric J. Robinson
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.
PMB 955
21010 Southbank Street
Potomac Falls, Virginia 20165
(571) 434-6789